

U.S. Application No. 09/746,054
Reply to Office Action of July 11, 2006

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450100-02906
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REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the following arguments.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-27 are pending in this application. Claims 1, 12, 21, 22, 25 and 26 are independent. It is submitted that these claims were patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112.

II. REJECTIONS UNDER 35 U.S.C. §103

Claims 1, 2, 3, and 25 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,631,523 to Matthews et al. (hereinafter, merely "Matthews") in view of U.S. Patent No. 5,880,720 to Iwafune et al. (hereinafter, merely "Iwafune"), U.S. Patent No. 5,847,703 to Teicher et al. (hereinafter, merely "Teicher"), U.S. Patent No. 5,945,987 to Dunn (hereinafter, merely "Dunn"), U.S. Patent No. 5,666,645 to Thomas et al. (hereinafter, merely "Thomas"), and U.S. Patent No. 6,898,762 to Ellis et al. (hereinafter, merely "Ellis").

Claim 4 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Matthews, in view of Iwafune, Teicher, Dunn, Thomas, and Ellis, and further in view of U.S. Patent No. 6,005,631 to Anderson et al. (hereinafter, merely "Anderson").

Claims 5, 6, and 7 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Matthews, in view of Iwafune, Teicher, Dunn, Thomas, and Ellis, and further in view of U.S. Patent No. 6,553,178 to Abecassis (hereinafter, merely "Abecassis").

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Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Matthews in view of Iwafune, Teicher, Dunn, Thomas and Ellis, and further in view of U.S. Published Application No. 2003/0056208 to Kamada et al. (hereinafter, merely "Kamada").

Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Matthews in view Iwafune, Teicher, Dunn, Thomas and Ellis, and Kamada, and further in view of U.S. Published Application No. 2003/0135853 to Goldman et al. (hereinafter, merely "Goldman").

Claims 12-15, 17-20, 22-24, 26, and 27 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Matthews in view of Iwafune, Teicher, Dunn, Thomas, and Ellis, and further in view of U.S. Published Application No. 2003/0135864 to Barth (hereinafter, merely "Barth").

Claim 16 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Matthews in view Iwafune, Teicher, Dunn, Thomas, Ellis, and Barth, and further in view of U.S. Patent No. 6,449,654 to Blackwell et al. (hereinafter, merely "Blackwell").

Claim 21 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Matthews in view Iwafune, Teicher, Thomas and Ellis.

III. RESPONSE TO REJECTIONS

As understood by Applicants, Teicher relates to an apparatus for browsing through a motion picture in order to locate desired segments in the motion picture, frames are selected from sequential parts of the motion picture according to predetermined sampling criteria, e.g., "by time", "by tag" or "by change". Each selected frame is reduced in size such that the screen can accommodate the simultaneous display of several frames. The frames are

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displayed sequentially at sequential locations on the screen according to a predefined closed loop, each frame being displayed in its respective location for a time interval starting with a time delay after the start of the display of the frame at the preceding location in the loop and continuing until the loop has been completed with another frame displayed in its respective location. Thus, only the selected frames need be viewed in order to locate a desired segment, but each selected frame may be viewed for an extended time interval.

Claim 1 recites, *inter alia*:

“...wherein said broadcasting contents information is processed to generate a child screen for each scene change of said broadcasting contents information...” (Emphasis added)

In page 4 of the Office Action, the Examiner contends that the server of Teicher's system processes the videos to generate miniaturized frames for each scene change. Applicants respectfully submit that the miniaturized frames of Teicher, however, are not corresponding to the “broadcasting contents information”. According to Teicher's figure 2, the image displayed on the screen 18 is divided into nine sub-frames 22, designated A through I. Each sub-frame displays, by its turn and for several seconds, a still image of a miniaturized frame, prepared by and received from frame composer 6 of server 2. Frame composer 6 of server 2 selects and processes these miniaturized frame according to the criteria in figure 4 of Teicher. In here, selection “by change” instructs sampling criteria detector 10 to identify scene changes in the browsed motion picture, which exceed a selectable threshold. The measured change relates to the relative percentage of the basic colors (e.g., Red, Green, Blue in an RGB scheme), the threshold being a parameter such as “20%, which implies selecting the first frame where the relative ratio between any of R/G, G/B or B/R changes by more than 20% in respect to the previous selected frame. Teicher col. 4, lines 29-37. Applicants submit that Teicher, however, does not teach or disclose the identified feature in claim 1. Specifically, Teicher does not teach

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or suggest the broadcasting contents information being processed to generate a child screen for each scene change of said broadcasting contents information.

Applicants further submit that nothing has been found in Matthews, Iwafune, Dunn, Thomas, or Ellis, taken alone or combination that would disclose or suggest the above-identified feature of claim 1. Specifically, Applicants respectfully submit that Matthews, Iwafune, Dunn, Thomas, and Ellis fail to teach or suggest that broadcasting contents information is processed to generate a child screen for each scene change of said broadcasting contents information, as recited in claim 1.

In addition, Applicants respectfully submit that the Office Action has relied on impermissible hindsight. On page 4 of the Office Action, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to combine all these references in order to derive the instant invention. Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings either in the references themselves or in the general knowledge available to one of ordinary skill in the art; second, there must be a reasonable expectation of success; third, the prior art reference or references must teach or suggest all the claim limitations. M.P.E.P. § 2143. It is, however, impermissible for the Examiner to use hindsight based on an Applicant's disclosure to determine that an Applicants' invention is obvious in view of the cited art. M.P.E.P. § 2142. The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant's disclosure. *In re Vaack*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). There is nothing that would motivate a skilled worker in the art to modify Matthews in view of all the other references.

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It is well established that when a rejection depends on a combination of references, there must be some teaching, suggestion or motivation to combine the references. *See In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed.Cir.1998). To prevent the use of hindsight, the examiner is required to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *Id* at 1357. Further, in *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340 (January 27, 2000), *reh'g en banc denied* (March 6, 2000), *cert. denied*, 120 S. Ct. 2679 (U.S. 2000), it was held that:

“Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘clear and particular.’” (emphasis added).

Additionally, Applicants submit that the Examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicants' disclosure. *Id*. Therefore, absent some teaching, suggestion, or incentive in the prior art, the cited references cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicants' disclosure as a model for the needed changes.

Furthermore, even if the Examiner has located all the limitations of the claimed present invention, which Applicants respectfully disagree, still a fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule

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that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention. The inquiry is not whether each element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 100, 2 U.S.P.Q.2d 1826 (Fed. Cir. 1987). Applicants respectfully point out that the Examiner has established a pattern of allegedly locating each element of the invention in the prior art and then combining the references to formulate the obviousness rejections.

For at least this reason of reconstruction based on impermissible hindsight, claim 1 should be allowed.

Claims 12, 21-22, and 25-26 are similar, or somewhat similar, in scope to claim 1, and are therefore patentable for similar, or somewhat similar, reasons.

IV. DEPENDENT CLAIMS

The other claims in this application are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

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CONCLUSION

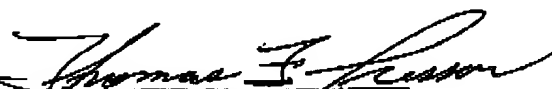
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate the portion, or portions, of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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